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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/747,936	OGG ET AL.	
	Examiner	Art Unit	
	NATHAN ERB	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 July 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10,12,13,15-18 and 21-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10,12,13,15-18,21-24 and 26* is/are rejected.

7)☒ Claim(s) *25* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 16, 2009, has been entered.

Response to Arguments

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Applicant's response to Office action was received on July 16, 2009.

4. With respect to the rejections of claims 4 and 26 under 35 U.S.C. 112, first paragraph, Applicant has amended the claims to attempt to overcome the rejections and pointed out a section of the specification that Applicant believes provides support for the claim language at issue (specification of application-as-filed, p. 19, lines 20-25). That section states:

> "In addition to customer-based reporting, the system will also provide system-wide reporting, including, by non-limiting example: mass mailing reports of everything in the system, facility problem reports, reports of items that have never been scanned, reports of items that were scanned at least once, but have

disappeared, average delivery time of mail pieces, average delivery time by region, and average delivery time by mail service class."

Examiner has amended the rejections of claims 4 and 26 under 35 U.S.C. 112, first paragraph, to correspond to the amendments. Examiner does not agree that the amendments overcome the rejections. As amended, the sections at issue in claims 4 and 26 determine that a particular tracking identifier cannot be found in the database of tracking records and return an indication of that determination. The closest concept to this in the above specification quotation appears to be "reports of items that have never been scanned," since the database is to be of only mailpieces that have been SCANNED at some point (see other language of claims 4 and 26); therefore, a report indicating mailpieces that have never been scanned would also be an indication of mailpieces that are not in the database and would not return a match. However, the rejections are not overcome because the indications in claims 4 and 26 are returned IN RESPONSE to a search for a particular tracking identifier in the database. This is NOT supported in the above-quoted portion of the specification. Rather, in the above-quoted portion of the specification, there may simply be a separate list of ALL issued tracking identifiers, with an identifier removed from the list whenever a mailpiece with that identifier is first scanned. Periodically, the remaining unscanned tracking identifiers could be output on a report. Such a configuration would correspond in result to the specification passage above, yet it would NOT involve ANY searching of a database of scanned mailpieces. Therefore, Applicant's claim language at issue would not necessarily follow from the above-quoted portion of the specification.

5. On the other hand, Examiner has found Applicant's comments to be persuasive with respect to the rejections of claims 8-9 under 35 U.S.C. 112, first paragraph, and those rejections are hereby withdrawn.

6. In response to Applicant's amendments and comments concerning the rejections under 35 U.S.C. 101, all of the claim rejections under 35 U.S.C. 101 from the previous Office action are hereby withdrawn.

7. Please note the new rejections under 35 U.S.C. 101 below in this Office action. Suggested claim amendments to attempt to overcome these rejections are included with the rejections below in this Office action.

8. In response to Applicant's amendment of the claims, the corresponding prior art claim rejections have been correspondingly amended below in this Office action.

9. Regarding the prior art rejections, Applicant argues that the claims have been distinguished from the prior art by adding a limitation that the tracking identifier is separate from the postage indicium. However, note that this limitation is also found in Montgomery (see paragraph [0038] of Montgomery, which discusses placing two barcodes on a mailpiece, one for the tracking identifier and one for the postage indicium). Therefore, Applicant's arguments are not persuasive with respect to this issue.

10. Applicant argues that a "mailing" may be not just one mailpiece, but multiple mailpieces. Examiner concedes that the plain meaning of the word "mailing" may refer to a single mailpiece or multiple mailpieces (for example, a company could complete a "mass-mailing"). However, with respect to the PLANET system, when it is said that a

PLANET code is used to track a mailing, the general idea is that the PLANET code is being used in combination with the POSTNET code to track individual mailpieces, to the extent that PLANET/POSTNET combinations don't repeat. See the Baker reference. Although the word "mailing" may be used for single or multiple mailpieces, the cited prior art does disclose the claim language in the manner of interpretation for "mailing" intended by Applicant's specification.

11. Applicant argues that a vendor ID cannot be an authorization for creating tracking codes, apparently because it may also be an authorization for vending computer-based postage. Examiner responds that there does not seem to be any reason that a vendor ID cannot represent more than one authorization, especially if it is needed for each such function.

12. With respect to Applicant's "ascending register" comments, Examiner admits to some accidental misstatements with respect to the previous Office action; however, the rejections are still valid. To further explain, paragraph [0089] of Montgomery, for example, describes the use of vendor ID/user account number/(and either piece count or ascending register) combinations to generate unique mailpiece identifiers. To an extent, since Montgomery said either could be used for the same purpose, Examiner inadvertently confused "piece count" and "ascending register." When piece count is used, the number representing piece count would increase by one as each mail piece is generated, therefore resulting in a unique combination of vendor ID/user account number/and piece count each time. Since ascending register is the so-called total value of postage printed for an account's lifetime, it also results in a unique combination of

vendor ID/user account number/and ascending register, with each mail piece printed, although it will be a different number than piece count. That is why either ascending register or piece count may be used. Nonetheless this iterative generation of unique combinations corresponds to the unique combinations generated in the respective claim limitations. Examiner apologizes to the extent that his previous explanation resulted in any confusion.

13. Applicant disputes Examiner's use of Watson to disclose "wherein a plurality of mailing tracking subscriber identifiers are assigned by the postal authority to a single entity, and identifying from the plurality of mailing tracking subscriber identifiers, a next available mailing tracking subscriber identifier." As explained by Examiner in the rejection, using a plurality of mailing subscriber identifiers would require that a subscriber be able to choose which one to use for the next destination confirm mailing. Applicant argued that the above explanation lacks a citation to a reference; however, that statement was simply an explanation of why the limitation was implicit in the reference and therefore did not require a citation. Regarding the argument that Watson does not fully disclose the "modifying" step, it is important to note that it is an obviousness rejection and that that step is disclosed via a combination of disclosures in the rejections, for example, including Montgomery.

14. Regarding Applicant's argument that the CONFIRM service in Watson would not necessarily result in unique tracking identifiers, Examiner is aware of this (see earlier discussion). However, when the cited aspects of Montgomery, for example, are added

to the combination, which are directed toward generating unique tracking identifiers, this would change.

15. Regarding Applicant's assertion of the usefulness of Applicant's invention, Examiner responds that, while Applicant's invention may be useful, it may still be obvious.

Claim Rejections - 35 USC § 112

16. Claims 4 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, after reviewing Applicant's specification, Examiner was unable to find support for the following limitations:

a. Claim 4: "for an electronic mail piece tracking identifier for which no match is found, using the computer-based postage system for reporting an indication that there is no tracking information available for the particular first class mail piece."

b. Claim 26: "for a tracking identifier for which no match is found, indicating that tracking status information was not found for the particular first class mail piece."

Claim Rejections - 35 USC § 101

17. Claims 10 and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

> "(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or

> thing' is the clue to the patentability of a process claim that does not include particular machines.'); Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing' '); Cochrane v. Deener, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.').[7] A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article." (*In re Bilski, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008)*)

Also noted in *Bilski* is the statement, "Process claim that recites fundamental principle, and that otherwise fails 'machine-or-transformation' test for whether such claim is drawn to patentable subject matter under 35 U.S.C. §101, is not rendered patent eligible by mere field-of-use limitations; another corollary to machine-or-transformation test is that recitation of specific machine or particular transformation of specific article does not transform unpatentable principle into patentable process if recited machine or transformation constitutes mere 'insignificant post-solution activity.'" (*In re Bilski, 88 USPQ2d 1385, 1385 (Fed. Cir. 2008)*) Examples of insignificant post-solution activity include data gathering and outputting. Furthermore, the machine or transformation must impose meaningful limits on the scope of the method claims in order to pass the machine-or-transformation test. Please refer to the USPTO's "Guidance for Examining Process Claims in view of *In re Bilski*" memorandum dated January 7, 2009, http://www.uspto.gov/web/offices/pac/dapp/opla/documents/bilski_guidance_memo.pdf .

It is also noted that the mere recitation of a machine in the preamble in a manner such that the machine fails to patentably limit the scope of the claim does not make the claim statutory under 35 U.S.C. § 101, as seen in the Board of Patent Appeals Informative Opinion *Ex parte Langemyr et al.* (Appeal 2008-1495), http://www.uspto.gov/web/offices/dcom/bpai/its/fd081495.pdf .

Claims 10 and 12 are not tied to a particular machine or apparatus nor do they transform a particular article into a different state or thing, thereby failing the machine-or-transformation test; therefore, claims 10 and 12 are non-statutory under § 101.

Appropriate correction is required.

Special Note (Examiner Suggestion): In order to attempt to overcome these rejections under 35 U.S.C. 101, Examiner suggests the following amendments:

1. In the ninth line of claim 10, after the word "assigning," please insert the text --, by a computer system,--.

2. In the twenty-fourth line of claim 10, after the word "encoding," please insert the text --, by the computer system,--.

Claim Rejections - 35 USC § 102

18. Claims 10, 12, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Montgomery et al., U.S. Patent Application Publication No. US 2003/0101143 A1

As per **Claim 10**, Montgomery et al. discloses:

- a method of encoding a trackable first class mail piece identifier as a graphic symbology (Figures 19 and 22; paragraph [0032]; paragraphs [0087]-[0088]; paragraph

[0089]; paragraphs [0090]-[0093]; ID is a tracking ID; does not exclude envelope mail; tracking numbers may be added to first class mail in the future; invention may be applied to first class mail pieces);

- receiving a request by a particular customer user of a plurality of customer users of a computer-based postage provider to print computer-based postage for a particular first class mail piece for mailing the particular first class mail piece to a particular delivery address, wherein the request to print computer-based postage comprises an indication by the particular customer user to track the particular first class mail piece (Figures 19 and 22; paragraph [0089]; paragraphs [0090]-[0093]; users request postal indicia from postal vendors; invention may be applied to first class mail pieces);

- assigning a tracking identifier to correspond to the particular customer user and to trackably correspond to the particular first class mail piece, wherein the tracking identifier trackably identifies the particular first class mail piece during a particular period of time, wherein the tracking identifier comprises a mailing subscriber identifier corresponding to an authorization to the computer-based postage provider by a postal authority for the computer-based postage provider to create machine-readable first class mailing tracking graphic symbologies, separate from postage indicia, for tracking first class mailings, in accordance with the authorization by the postal authority, the tracking identifier further comprising a mailing identifier, and a delivery address identifier, wherein the delivery address identifier is trackably unique within a combination of the mailing subscriber identifier and the mailing identifier during a period

of time (Figures 19 and 22; paragraph [0004]; paragraphs [0024]-[0025]; paragraph [0032]; paragraph [0038]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; invention may be applied to first class mail pieces; mailing subscriber identifier is vendor ID; ID is a tracking ID; mailing identifier is user account number plus piece count [or ascending register]; vendor ID plus user account number plus piece count [or ascending register] is to be unique over a period of time, thereby allowing tracking; may include POSTNET bar code, which identifies delivery address);

- encoding the tracking identifier as a machine-readable graphic symbology, separate from computer-based postage indicia, in accordance with the authorization by the postal authority, said machine-readable graphic symbology adapted for fixing in a visual medium that is adapted for physical association with the particular first class mail piece (Figure 19; paragraph [0038]; paragraphs [0087]-[0088]; paragraph [0089]; paragraph [0146]);

- saving in a memory storage a relationship between the tracking identifier and the particular customer user (paragraph [0089]; paragraphs [0190]-[0194]; user account number that is part of the tracking ID identifies a particular user).

As per **Claim 12**, Montgomery et al. further discloses wherein encoding the tracking identifier as a graphic symbology comprises encoding the tracking identifier as a machine-readable bar code (Figure 19; paragraphs [0087]-[0088]; paragraph [0089]; paragraph [0146]).

As per **Claim 18**, Montgomery et al. discloses:

- a method using a computer-based postage system for printing a trackable first class mail piece identifier for a first class mail piece (Figures 19 and 22; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; ID is a tracking ID; does not exclude envelope mail; tracking numbers may be added to first class mail in the future; invention may be applied to first class mail pieces; system uses computers);

- using the computer-based postage system for generating for printing on a remote printer in communication with a remote client computer, computer-based postage indicia for a particular first class mail piece in accordance with a postage printing request by a particular customer user of a plurality of customer users of the computer-based postage system, wherein the postage printing request comprises a delivery address (paragraph [0096]; paragraph [0133]);

- using the computer-based postage system for generating a first class mail piece tracking identifier for the particular first class mail piece, wherein the first class mail piece tracking identifier comprises: a mailing subscriber identifier corresponding to an authorization by a governmental postal authority to a computer-based postage provider associated with the computer-based postage system, to create for customer users of the computer-based postage system, machine-readable, graphic symbologies for tracking first class mail pieces, a mailing identifier, and a delivery address identifier corresponding to the delivery address, wherein the delivery address is trackably unique within a combination of the mailing subscriber identifier and the mailing identifier during

a particular period of time (paragraphs [0024]-[0025]; paragraph [0089]; paragraphs [0090]-[0093]; paragraph [0095]; paragraph [0104]; vendor ID [described as possibly part of a "Device ID"] is assigned by USPS; tracking provider is a postal vendor; mailing identifier is user account number plus piece count [or ascending register]; mailing subscriber identifier is vendor ID; vendor ID plus user account number plus piece count [or ascending register] is to be unique over a period of time, thereby allowing tracking);

- using the computer-based postage system for encoding the first class mail piece tracking identifier as a machine-readable barcode apart from computer-based postage indicia for the particular first class mail piece (Figure 19; paragraph [0038]; paragraphs [0087]-[0088]; paragraph [0089]; paragraph [0146]);

- using the computer-based postage system for storing in a computer-accessible memory, a set of information relating the first class mail piece tracking identifier to the particular customer user (paragraph [0089]; paragraphs [0190]-[0194]; user account number that is part of the tracking ID identifies a particular user);

- using the computer-based postage system for generating for printing, a printable format of the machine-readable barcode (Figure 19; paragraphs [0087]-[0088]; paragraph [0089]; paragraph [0146]).

Claim Rejections - 35 USC § 103

19. Claims 1-3, 5, and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al. in view of Baker et al., U.S. Patent Application Publication No. US 2004/0215478 A1, in further view of Watson, Neva, "Changes to the

Domestic Mail Manual to Implement Confirm (R) -- Service," 67 FR 53454, August 15, 2002.

As per **Claim 1**, Montgomery et al. discloses:

- a computer-implemented method for a first class mail piece tracking provider to provide, to a plurality of customers of the first class mail piece tracking provider, tracking of individual outbound first class mail pieces respectively initiated in a mail stream by respective customers of the plurality of customers, said method implemented using a computer-based postage system programmed for operation on behalf of the first class mail piece tracking provider, said computer-based postage system available for communication with each respective customer of the plurality of customers, said method comprising the computer-based postage system programmed (Figures 19 and 22; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; paragraph [0168]; paragraph [0183]; ID is a tracking ID; does not exclude envelope mail; tracking numbers may be added to first class mail in the future; invention may be applied to first class mail pieces; tracking provider is a postal vendor; system uses computers);

- using the computer-based postage system for recording a mailing tracking subscriber identifier assigned by a postal authority to the first class mail piece tracking provider, the mailing tracking subscriber identifier corresponding to an authorization by the postal authority to the first class mail piece tracking provider to create machine-readable tracking graphic symbologies, separate from postage indicia, for tracking first

class mailings that bear machine-readable tracking graphic symbologies created in accordance with the authorization by the postal authority to the first class mail piece tracking provider (Figures 19 and 22; paragraphs [0033]-[0035]; paragraph [0038]; paragraph [0089]; paragraphs [0090]-[0093]; paragraph [0104]; mailing subscriber identifier is vendor ID; vendor ID [described as possibly part of a "Device ID"] is assigned by USPS; tracking provider is a postal vendor);

- using the computer-based postage system for receiving, from a particular customer of the plurality of customers of the first class mail piece tracking provider, a request for postage indicia to mail a particular first class mail piece to a delivery address, wherein the request from the particular customer to mail the particular first class mail piece comprises an indication by the particular customer to provide tracking of the particular first class mail piece (Figures 19 and 22; paragraph [0089]; paragraphs [0090]-[0093]; users request postal indicia from postal vendors; postal indicia contain tracking IDs; request is thus at least an implicit indication by user to provide tracking; invention may be applied to first class mail pieces);

- using the computer-based postage system for determining a delivery address identifier corresponding to the delivery address (paragraph [0004]; paragraphs [0087]-[0088]; may include POSTNET bar code, which identifies delivery address);

- using the computer-based postage system for identifying a next available mailing tracking identifier (paragraphs [0024]-[0025]; paragraph [0089]; paragraphs [0090]-[0093]; mailing identifier is user account number plus piece count [or ascending register]);

- using the computer-based postage system for modifying at least one of the next available mailing tracking subscriber identifier and the next available mailing identifier, until determining a combination of a destination tracking service type, the next available mailing tracking subscriber identifier, the next available mailing identifier, and the delivery address identifier corresponding to the delivery address, to comprise a first class mail piece tracking identifier that would trackably identify the particular first class mail piece during a particular period of time in accordance with the authorization by the postal authority to the first class mail piece tracking provider for tracking first class mailings (paragraphs [0024]-[0025]; paragraph [0089]; paragraphs [0090]-[0093]; mailing identifier is user account number plus piece count [or ascending register]; mailing subscriber identifier is vendor ID; vendor ID plus user account number plus piece count [or ascending register] is to be unique over a period of time, thereby allowing tracking; taking the ascending register would always result in a new unique combination in this new environment, thereby fulfilling this condition and not needing to consider any further combinations);

- using the computer-based postage system for assigning the first class mail piece tracking identifier to the particular first class mail piece, wherein the first class mail piece tracking identifier trackably identifies the particular first class mail piece during the particular period of time (Figures 19 and 22; paragraph [0004]; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; invention may be applied to first class mail pieces; mailing subscriber identifier is vendor ID; ID is a tracking ID; mailing identifier is user account number plus piece count [or ascending

register]; vendor ID plus user account number plus piece count [or ascending register] is to be unique over a period of time, thereby allowing tracking);

- using the computer-based postage system for creating a machine-readable tracking graphic symbology, separate from postage indicia, comprising the first class mail piece tracking identifier (Figure 19; Figure 22; paragraph [0038]);

- using the computer-based postage system for relating the first class mail piece tracking identifier to the particular customer of the plurality of customers (paragraph [0089]; paragraphs [0090]-[0093]; account number in vendor ID plus user account number plus piece count [or ascending register] relates the mail piece to a user).

Montgomery et al. fails to disclose wherein the tracking identifier includes the destination tracking service type. Baker et al. discloses wherein the tracking identifier includes the destination tracking service type (paragraph [0002]; paragraph [0020]; paragraph [0028]; first two digits of PLANET code is service type). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. such that the tracking identifier includes the destination tracking service type, as disclosed by Baker et al. Motivation is provided by Baker et al. in that the service type indicates whether an origin CONFIRM service or a destination CONFIRM service is desired (paragraph [0002]; paragraph [0020]; paragraph [0028]).

Montgomery et al. and Baker et al. fail to disclose wherein a plurality of mailing tracking subscriber identifiers are assigned by the postal authority to a single entity, and identifying from the plurality of mailing tracking subscriber identifiers, a next available

mailing tracking subscriber identifier. Watson discloses wherein a plurality of mailing tracking subscriber identifiers are assigned by the postal authority to a single entity, and identifying from the plurality of mailing tracking subscriber identifiers, a next available mailing tracking subscriber identifier (p. 3, section A; p. 6, section B; p. 9, section C; using a plurality of mailing subscriber identifiers would require that a subscriber be able to choose which one to use for the next destination confirm mailing). Therefore, the prior art included each element claimed although not necessarily in a single reference. One of ordinary skill in the art could have combined the elements as claimed by known methods (this is simply a matter of allowing a vendor in Montgomery et al. to distribute tracking numbers using more than one different vendor ID; everything would operate the same for different vendor numbers, other than the vendor numbers themselves being different; associating additional vendor IDs with a single vendor can be done simply by adding the additional vendor IDs to a computer file which includes such information about the vendor). In combination, each element merely would have performed the same function as it did separately (again, Montgomery et al.'s tracking system would operate the same for different vendor IDs for the same vendor, with the exception that the vendor IDs themselves would be different; changing the vendor ID would not interfere with being able to indicate the destination tracking service type in the tracking identifier, as in Baker et al.; having multiple vendor/subscriber IDs would still serve the function that they do in Watson, allowing the tracking of more mailpieces). One of ordinary skill in the art would have recognized that the results of the combination were predictable (this is simply substituting one arbitrary ID number in place of another

arbitrary ID number, as part of a tracking number; since the vendor numbers themselves could be any values, as long as they are each associated with a single vendor, the system of Montgomery et al. should be expected to function quite the same as vendor IDs are varied for a given vendor). Thus, the combination would have been obvious.

As per **Claim 2**, Montgomery et al. further discloses said method further comprising: using the computer-based postage system for facilitating fixing the machine-readable tracking graphic symbology in a visual medium, said visual medium adapted for physical association with the particular first class mail piece (Figure 19; paragraphs [0087]-[0088]; paragraph [0089]; paragraph [0146]).

As per **Claim 3**, Montgomery et al. further discloses said method further comprising: physically associating the machine-readable tracking graphic symbology fixed in the visual medium with the particular first class mail piece (Figure 19; paragraphs [0087]-[0088]; paragraph [0089]; paragraph [0146]).

As per **Claim 5**, Montgomery et al. fails to disclose wherein the mail piece tracking identifier further comprises: a service type. Baker et al. further discloses wherein the mail piece tracking identifier further comprises: a service type (paragraph [0002]; paragraph [0020]; paragraph [0028]). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of

Montgomery et al. as modified in the rejection for claim 1 such that the mail piece tracking identifier further comprises: a service type, as disclosed by Baker et al. Motivation is provided by Baker et al. in that the service type indicates whether an origin CONFIRM service or a destination CONFIRM service is desired (paragraph [0002]; paragraph [0020]; paragraph [0028]).

As per **Claim 7**, Montgomery et al. further discloses the method further comprising: using the computer-based postage system for formatting the machine-readable tracking graphic symbology as bar code, for print rendering as a label for the particular first class mail piece (Figure 19; paragraphs [0087]-[0088]; paragraph [0089]; paragraph [0146]).

As per **Claim 8**, Montgomery et al. discloses:

- a computer program product, comprising a computer-readable medium having a computer-readable program code embodied therein, said computer-readable program code adapted to be executed to implement a method for printably rendering a trackable mail piece identifier graphic symbology (Figure 19; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0095]-[0098]; paragraph [0146]);

- encoding a mailing subscriber identifier corresponding to a mailing subscriber identifier assigned by a postal authority to a first class mail piece tracking provider, wherein each mailing subscriber identifier corresponds to an authorization to the first class mail piece tracking provider by the postal authority for creating machine-readable

tracking barcodes, separate from postage indicia, for tracking first class mailings that bear machine-readable tracking barcodes created in accordance with the authorization by the postal authority to the first class mail piece tracking provider (Figures 19 and 22; paragraph [0038]; paragraph [0089]; paragraphs [0090]-[0093]; paragraph [0104]; mailing subscriber identifier is vendor ID; vendor ID [described as possibly part of a "Device ID"] is assigned by USPS; tracking provider is a postal vendor);

- encoding a mailing identifier as an encoded mailing identifier, the encoded mailing identifier comprising an encoding of a mailing identifier corresponding to a particular customer user of a plurality of customer users of the first class mail piece tracking provider (Figure 19; paragraphs [0024]-[0025]; paragraph [0089]; paragraphs [0090]-[0093]; mailing identifier is user account number plus piece count [or ascending register]; mailing subscriber identifier is vendor ID; vendor ID plus user account number plus piece count [or ascending register] is to be unique over a period of time, thereby allowing tracking);

- encoding a delivery address identifier corresponding to a delivery address to which the particular customer user has requested destination tracking of a particular first class mail piece; creating a first class mail piece tracking identifier comprising a combination of the encoded mailing subscriber identifier, the encoded mailing identifier, and the encoded delivery address identifier corresponding to the delivery address, the first class mail piece tracking identifier trackably identifies the particular first class mail piece during a particular period of time in accordance with the authorization by the postal authority to the first class mail piece tracking provider for tracking first class

mailings and that is associated with the particular customer user (Figures 19 and 22; paragraph [0004]; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; invention may be applied to first class mail pieces; mailing subscriber identifier is vendor ID; ID is a tracking ID; mailing identifier is user account number plus piece count [or ascending register]; vendor ID plus user account number plus piece count [or ascending register] is to be unique over a period of time, thereby allowing tracking; may include POSTNET bar code, which identifies delivery address).

- formatting for print-rendering, a machine-readable tracking barcode, exclusive of postage indicia, the machine-readable tracking barcode comprising the first class mail piece tracking identifier (Figure 19; Figure 22; paragraph [0038]).

Montgomery et al. fails to disclose encoding a destination tracking service type. Baker et al. discloses encoding a destination tracking service type (paragraph [0002]; paragraph [0020]; paragraph [0028]; first two digits of PLANET code is service type). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. such that it encodes a destination tracking service type, as disclosed by Baker et al. Motivation is provided by Baker et al. in that the service type indicates whether an origin CONFIRM service or a destination CONFIRM service is desired (paragraph [0002]; paragraph [0020]; paragraph [0028]).

Montgomery et al. fails to disclose wherein the tracking identifier includes the encoded destination tracking service type. Baker et al. further discloses wherein the tracking identifier includes the encoded destination tracking service type (paragraph [0002]; paragraph [0020]; paragraph [0028]; first two digits of PLANET code is service

type). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. as modified above in this rejection such that the tracking identifier includes the encoded destination tracking service type, as disclosed by Baker et al. Motivation is provided by Baker et al. in that the service type indicates whether an origin CONFIRM service or a destination CONFIRM service is desired (paragraph [0002]; paragraph [0020]; paragraph [0028]).

Montgomery et al. and Baker et al. fail to disclose wherein a plurality of mailing subscriber identifiers are assigned by the postal authority to a single entity. Watson discloses wherein a plurality of mailing subscriber identifiers are assigned by the postal authority to a single entity (p. 3, section A; p. 6, section B; p. 9, section C; using a plurality of mailing subscriber identifiers would require that a subscriber be able to choose which one to use for the next destination confirm mailing). Therefore, the prior art included each element claimed although not necessarily in a single reference. One of ordinary skill in the art could have combined the elements as claimed by known methods (this is simply a matter of allowing a vendor in Montgomery et al. to distribute tracking numbers using more than one different vendor ID; everything would operate the same for different vendor numbers, other than the vendor numbers themselves being different; associating additional vendor IDs with a single vendor can be done simply by adding the additional vendor IDs to a computer file which includes such information about the vendor). In combination, each element merely would have performed the same function as it did separately (again, Montgomery et al.'s tracking system would operate the same for different vendor IDs for the same vendor, with the exception that

the vendor IDs themselves would be different; changing the vendor ID would not interfere with being able to indicate the destination tracking service type in the tracking identifier, as in Baker et al.; having multiple vendor/subscriber IDs would still serve the function that they do in Watson, allowing the tracking of more mailpieces). One of ordinary skill in the art would have recognized that the results of the combination were predictable (this is simply substituting one arbitrary ID number in place of another arbitrary ID number, as part of a tracking number; since the vendor numbers themselves could be any values, as long as they are each associated with a single vendor, the system of Montgomery et al. should be expected to function quite the same as vendor IDs are varied for a given vendor). Thus, the combination would have been obvious.

As per **Claim 9**, Montgomery et al. further discloses said method further comprising: wherein the delivery address identifier is trackably unique during a particular period of time, within a combination the encoded mailing subscriber identifier and the encoded mailing identifier (Figures 19 and 22; paragraph [0004]; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]).

Montgomery et al. fails to disclose before formatting the machine-readable tracking barcode: encoding as an encoded service type identifier, a service type identifier; creating the mail piece tracking identifier comprising a combination of the encoded destination tracking service type, the encoded mailing subscriber identifier, the encoded mailing identifier, the encoded delivery address identifier corresponding to the

delivery address, and the encoded service type identifier. Baker et al. further discloses before formatting the machine-readable tracking barcode: encoding as an encoded service type identifier, a service type identifier (paragraph [0002]; paragraph [0020]; paragraph [0028]; first two digits of PLANET code is service type); creating the mail piece tracking identifier comprising a combination of the encoded destination tracking service type, the encoded mailing subscriber identifier, the encoded mailing identifier, the encoded delivery address identifier corresponding to the delivery address, and the encoded service type identifier (Figure 4; paragraphs [0004]-[0010]). It would have been obvious to one of ordinary skill in the art to modify the invention of Montgomery such that, before formatting the machine-readable tracking barcode: it encodes as an encoded service type identifier, a service type identifier; and it creates the mail piece tracking identifier comprising a combination of the encoded destination tracking service type, the encoded mailing subscriber identifier, the encoded mailing identifier, the encoded delivery address identifier corresponding to the delivery address, and the encoded service type identifier, as disclosed by Baker, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

20. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al. in view of Baker et al. in further view of Watson in further view of Leon, U.S. Patent No. 7,069,253 B2.

As per **Claim 4**, Montgomery et al. further discloses said method further comprising: using the computer-based postage system for accessing a plurality of electronic mail piece tracking identifier representations, presented by the postal authority, each electronic mail piece tracking identifier representation of the plurality of electronic mail piece tracking identifier representations corresponding to one scanned first class mail piece tracking identifier of a plurality of scanned first class mail piece tracking identifiers produced in accordance with the authorization by the postal authority to the first class mail piece tracking provider for tracking first class mailings; using the computer-based postage system for searching the plurality of electronic mail piece tracking identifier representations for an electronic mail piece tracking identifier that matches the first class mail piece tracking identifier that trackably identifies the particular first class mail piece (Figures 19 and 22; paragraphs [0087]-[0088]; paragraphs [0190]-[0194]).

Montgomery et al., Baker et al., and Watson fail to disclose a postal services vendor receiving from the particular user a request for tracking information regarding the particular first class mail piece and, for an electronic mail piece tracking identifier that matches the first class mail piece tracking identifier that trackably identifies the particular first class mail piece, using the computer-based postage system for reporting to the particular user, tracking information associated with the electronic mail piece tracking identifier. Leon discloses a postal services vendor receiving from the particular user a request for tracking information regarding the particular first class mail piece and, for an electronic mail piece tracking identifier that matches the first class mail piece

tracking identifier that trackably identifies the particular first class mail piece, using the computer-based postage system for reporting to the particular user, tracking information associated with the electronic mail piece tracking identifier (Figure 1; column 4, lines 1-55; column 8, lines 21-43; column 14, lines 26-47; column 21, line 19, through column 22, line 30). Therefore, the prior art included each element claimed although not necessarily in a single reference. One of ordinary skill in the art could have combined the elements as claimed by known methods (this is simply allowing an end user mailer to access the tracking information stored in the vendor database of Montgomery et al.; allowing multiple parties access to information in a database was well-known to one of ordinary skill in the art at the time of Applicants' invention). In combination, each element merely would have performed the same function as it did separately (Montgomery et al.'s elements would still be providing a unique tracking identifier to a mail piece; Baker et al.'s element would still allow for the communication of the service type for a mail piece; Watson's element would still allow for the tracking of more mailpieces; Leon's element would still allow a mailer to conveniently access tracking information concerning a mail piece). One of ordinary skill in the art would have recognized that the results of the combination were predictable (simply increasing access to the tracking database does not interfere with the other elements; nor does allowing the end user mailer to access the database in this context lead to any surprising results). Thus, the combination would have been obvious.

Montgomery et al. fails to disclose, for a search query for which no match is found, reporting an indication that there is no matching information available for the

particular search query. However, Examiner hereby takes Official Notice that that element/limitation was well-known to one of ordinary skill in the art at the time of Applicant's invention (search tools commonly returned messages such as "no matches found" when a search query turned up no results). It would have been obvious to one of ordinary skill in the art to modify the invention of Montgomery et al. such that, for a search query for which no match is found, it reports an indication that there is no matching information available for the particular search query, as disclosed by Official Notice, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

21. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al. in view of Baker et al. in further view of Watson in further view of Denman, U.S. Patent No. 5,737,729.

As per **Claim 6**, Montgomery et al., Baker et al., and Watson fail to disclose wherein the delivery address identifier is obtained from Internet-based postage delivery address information. Denman discloses wherein the delivery address identifier is obtained from Internet-based postage delivery address information (column 2, lines 27-45; column 5, lines 15-53; column 6, lines 14-52). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. as modified in the rejection for claim 5 such that the delivery address

identifier is obtained from Internet-based postage delivery address information, as disclosed by Denman. Motivation is provided by Denman in that such a configuration allows for address searching (column 2, lines 27-45; column 5, lines 15-53; column 6, lines 14-52).

22. Claims 13 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al. in view of Baker et al.

As per **Claim 13**, Montgomery et al. discloses:

- a computer-implemented method for tracking individual outbound first class mail pieces, said method implemented using a computer-based postage system (Figures 19 and 22; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; ID is a tracking ID; does not exclude envelope mail; tracking numbers may be added to first class mail in the future; invention may be applied to first class mail pieces);

- using the computer-based postage system for receiving a postage printing request from a particular customer user of a plurality of customer users using a computer-based postage provider, said postage printing request comprising a request for computer-based postage indicia for mailing a particular first class mail piece to a delivery address, the request from the particular user for computer-based postage indicia for mailing the particular first class mail piece further comprising an indication by the particular user to provide tracking of the particular first class mail piece (Figures 19 and 22; paragraph [0089]; paragraphs [0090]-[0093]; users request postal indicia from

postal vendors; postal indicia contain tracking IDs; request is thus at least an implicit indication by user to provide tracking; invention may be applied to first class mail pieces);

- using the computer-based postage system for determining a delivery address identifier corresponding to the delivery address (paragraph [0004]; paragraphs [0087]-[0088]; may include POSTNET bar code, which identifies delivery address);

- using the computer-based postage system for formulating a next available first class mail piece identifier that would trackably identify the particular first class mail piece during a particular period of time, said first class mail piece identifier comprising a trackable combination of: a next available mailing subscriber identifier corresponding to an authorization to the computer-based postage provider by a governmental postal authority for the computer-based postage provider to generate for customer users of the computer-based postage provider, machine-readable, graphic symbologies, apart from computer-based postage indicia, representing tracking identifiers for first class mail pieces, a next available mailing identifier, and the delivery address identifier corresponding to the delivery address (Figures 19 and 22; paragraph [0004]; paragraph [0032]; paragraph [0038]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; paragraph [0104]; vendor ID [described as possibly part of a "Device ID"] is assigned by USPS; invention may be applied to first class mail pieces; mailing subscriber identifier is vendor ID; ID is a tracking ID; mailing identifier is user account number plus piece count [or ascending register]; vendor ID plus user account number

plus piece count [or ascending register] is to be unique over a period of time, thereby allowing tracking; may include POSTNET bar code, which identifies delivery address);

- using the computer-based postage system for encoding the next available first class mail piece identifier as a machine-readable graphic symbology (Figure 19; paragraphs [0087]-[0088]; paragraph [0089]; paragraph [0146]);

- using the computer-based postage system for storing in a computer-accessible memory, an association between the particular customer user and the next available first class mail piece identifier (paragraph [0089]; paragraphs [0190]-[0194]; user account number that is part of the tracking ID identifies a particular user).

Montgomery et al. fails to disclose wherein the tracking identifier includes the destination tracking service type. Baker et al. discloses wherein the tracking identifier includes the destination tracking service type (paragraph [0002]; paragraph [0020]; paragraph [0028]; first two digits of PLANET code is service type). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. such that the tracking identifier includes the destination tracking service type, as disclosed by Baker et al. Motivation is provided by Baker et al. in that the service type indicates whether an origin CONFIRM service or a destination CONFIRM service is desired (paragraph [0002]; paragraph [0020]; paragraph [0028]).

As per **Claim 15**, Montgomery et al. further discloses wherein the machine-readable graphic symbology comprises a one-dimensional bar-code (Figures 20 and 21; paragraph [0146]).

As per **Claim 16**, Montgomery et al. further discloses said method further comprising: using the computer-based postage system for responding to an indication by the particular customer user to print the machine readable graphic symbology by transmitting for printing the machine-readable graphic symbology (paragraph [0095]).

As per **Claim 17**, Montgomery et al. further discloses said method further comprising: using the computer-based postage system for generating for printing, computer-based postage indicia in accordance with the postage printing request (paragraph [0133]).

23. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al.

As per **Claim 21**, Montgomery et al. fails to disclose wherein the computer-based postage indicia is formatted for printing on a first label and wherein the first class mail piece tracking identifier is formatted for printing on a second label. However, that element/limitation was well-known to one of ordinary skill in the art at the time of Applicants' invention (two labels are often used in the corner and center of envelopes, for example). It would have been obvious to one of ordinary skill in the art at the time of

Applicants' invention to modify the invention of Montgomery et al. such that the computer-based postage indicia is formatted for printing on a first label and the first class mail piece tracking identifier is formatted for printing on a second label, as was well-known to one of ordinary skill in the art at the time of Applicants' invention. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of Applicants' invention that tracking information is sometimes placed near the address information in the center of an envelope instead of near the postage indicium in the corner of the envelope.

As per **Claim 22**, Montgomery et al. fails to disclose wherein the computer-based postage indicia and the first class mail piece tracking identifier are formatted for printing on an envelope. However, that element/limitation was well-known to one of ordinary skill in the art at the time of Applicants' invention (postal meters often can print on envelopes or labels). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. such that the computer-based postage indicia and the first class mail piece tracking identifier are formatted for printing on an envelope, as was well-known to one of ordinary skill in the art at the time of Applicants' invention. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of Applicants' invention that envelopes and labels may each be preferred in different circumstances.

24. Claims 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al. in view of Leon.

As per **Claim 23**, Montgomery et al. discloses:

- a method for retrieving a trackable first class mail piece identifier using a computer-based postage system (Figures 19 and 22; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; paragraphs [0190]-[0194]; ID is a tracking ID; does not exclude envelope mail; tracking numbers may be added to first class mail in the future; invention may be applied to first class mail pieces; system uses computers);

- using the computer-based postage system for retrieving, from a plurality of electronic first class mail piece identifier representations presented by a governmental postal authority, an electronic first class mail piece identifier representation, separate from postage indicia, said electronic first class mail piece identifier representation corresponding to a scanned machine-readable barcode that matches a particular first class mail piece identifier that trackably identifies a particular first class mail piece during a particular period of time and that corresponds to a particular customer user of a plurality of customer users of the computer-based postage system, said particular first class mail piece identifier generated by the computer-based postage system according to an authorization by the governmental postal authority to a computer-based postage provider associated with the computer-based postage system, to create for customer users of the computer-based postage system, separate from computer-based postage indicia, machine-readable, barcodes for tracking first class mail pieces (Figures 19 and 22; paragraph [0032]; paragraph [0038]; paragraphs [0087]-[0088]; paragraph [0089];

paragraphs [0090]-[0093]; paragraphs [0190]-[0194]; ID is a tracking ID; does not exclude envelope mail; tracking numbers may be added to first class mail in the future; invention may be applied to first class mail pieces).

Montgomery et al. fails to disclose a postage vendor reporting to a display device in communication with a client computer corresponding to the particular customer user, a set of tracking information associated with the electronic first class mail piece identifier representation. Leon discloses a postage vendor reporting to a display device in communication with a client computer corresponding to the particular customer user, a set of tracking information associated with the electronic first class mail piece identifier representation (Figure 1; column 4, lines 1-55; column 8, lines 21-43; column 14, lines 26-47; column 21, line 19, through column 22, line 30). Therefore, the prior art included each element claimed although not necessarily in a single reference. One of ordinary skill in the art could have combined the elements as claimed by known methods (this is simply allowing an end user mailer to access the tracking information stored in the vendor database of Montgomery et al.; allowing multiple parties access to information in a database was well-known to one of ordinary skill in the art at the time of Applicants' invention). In combination, each element merely would have performed the same function as it did separately (Montgomery et al.'s elements would still be providing a unique tracking identifier to a mail piece; Leon's element would still allow a mailer to conveniently access tracking information concerning a mail piece). One of ordinary skill in the art would have recognized that the results of the combination were predictable (simply increasing access to the tracking database does not interfere with the other

elements; nor does allowing the end user mailer to access the database in this context lead to any surprising results). Thus, the combination would have been obvious.

As per **Claim 26**, Montgomery et al. further discloses accessing a plurality of electronic mail piece representations presented by the postal authority, each electronic mail piece representation of the plurality of electronic mail piece representations corresponding to a machine sensing of a machine-readable graphic symbology created in accordance with the authorization by the postal authority, and each electronic mail piece representation comprising an indication of a corresponding tracking identifier and a corresponding set of information regarding a status of a respective first class mail piece in a mail stream processed by the postal authority; saving in a computer-accessible memory, each electronic mail piece representation with the corresponding tracking identifier and the corresponding set of information regarding the status of the respective first class mail piece (Figures 19 and 22; paragraphs [0087]-[0088]; paragraphs [0190]-[0194]). Montgomery et al. fails to disclose searching the computer-accessible memory for a stored tracking identifier that matches the tracking identifier that trackably corresponds to the particular first class mail piece; for a match between a stored tracking identifier and the tracking identifier that trackably corresponds to the particular first class mail piece, reporting to the particular customer user, at least a portion of the corresponding set of information regarding the status of the particular first class mail piece. Leon discloses searching the computer-accessible memory for a stored tracking identifier that matches the tracking identifier that trackably corresponds

to the particular first class mail piece; for a match between a stored tracking identifier and the tracking identifier that trackably corresponds to the particular first class mail piece, reporting to the particular customer user, at least a portion of the corresponding set of information regarding the status of the particular first class mail piece (Figure 1; column 4, lines 1-55; column 8, lines 21-43; column 14, lines 26-47; column 21, line 19, through column 22, line 30). It would have been obvious to one of ordinary skill in the art to modify the invention of Montgomery et al. such that it searches the computer-accessible memory for a stored tracking identifier that matches the tracking identifier that trackably corresponds to the particular first class mail piece; and, for a match between a stored tracking identifier and the tracking identifier that trackably corresponds to the particular first class mail piece, reports to the particular customer user, at least a portion of the corresponding set of information regarding the status of the particular first class mail piece, as disclosed by Leon, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Montgomery et al. fails to disclose, for a search query for which no match is found, reporting an indication that there is no matching information available for the particular search query. However, Examiner hereby takes Official Notice that that element/limitation was well-known to one of ordinary skill in the art at the time of Applicant's invention (search tools commonly returned messages such as "no matches found" when a search query turned up no results). It would have been obvious to one of

ordinary skill in the art to modify the invention of Montgomery et al. such that, for a search query for which no match is found, it reports an indication that there is no matching information available for the particular search query, as disclosed by Official Notice, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

25. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baker et al. in view of Montgomery et al.

As per **Claim 24**, Baker et al. discloses:

- a method for tracking individual outbound mail pieces using a computer-based system (paragraph [0002]; paragraphs [0004]-[0010]; paragraph [0020]; paragraph [0028]);

- using the computer-based system for assigning a composite confirm identifier to a particular mail piece according to input by a particular mailer of a plurality of mailers that are customers of the computer-based postage system, wherein said composite confirm identifier trackably identifies the particular mail piece during a particular period of time (paragraph [0002]; paragraphs [0004]-[0010]; paragraph [0020]; paragraph [0028]; paragraph [0035]);

- using the computer-based system for relating the composite confirm identifier for the particular mail piece to the particular mailer (paragraph [0002]; paragraphs [0004]-[0010]; paragraph [0020]; paragraph [0028]);

- using the computer-based system for receiving a scanning event about the composite confirm identifier scanned by the postal authority (paragraphs [0005]-[0007]; paragraph [0025]);

- using the computer-based system for reporting the scanning event to the particular mailer (paragraphs [0005]-[0007]; paragraph [0025]).

Baker et al. fails to disclose wherein mail pieces are first class mail pieces; wherein the tracking identifier is assigned according to an authorization by a postal authority to a computer-based postage provider associated with the computer-based postage system, to create for mailers that are customers of the computer-based postage system, machine-readable, barcodes for tracking mail pieces; using the computer-based postage system for encoding the tracking identifier as a machine-readable barcode, separate from postage indicia, according to the authorization by the postal authority. Montgomery et al. discloses wherein mail pieces are first class mail pieces; wherein the tracking identifier is assigned according to an authorization by a postal authority to a computer-based postage provider associated with the computer-based postage system, to create for mailers that are customers of the computer-based postage system, machine-readable, barcodes for tracking mail pieces; using the computer-based postage system for encoding the tracking identifier as a machine-readable barcode, separate from postage indicia, according to the authorization by the

postal authority (Figures 19 and 22; paragraph [0004]; paragraphs [0024]-[0025]; paragraph [0032]; paragraph [0038]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; paragraph [0146]). It would have been obvious to one of ordinary skill in the art to modify the invention of Baker et al. such that mail pieces are first class mail pieces; the tracking identifier is assigned according to an authorization by a postal authority to a computer-based postage provider associated with the computer-based postage system, to create for mailers that are customers of the computer-based postage system, machine-readable, barcodes for tracking mail pieces; and the invention uses the computer-based postage system for encoding the tracking identifier as a machine-readable barcode, separate from postage indicia, according to the authorization by the postal authority, as disclosed by Montgomery et al., since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Allowable Subject Matter

26. Claim 25 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NATHAN ERB whose telephone number is (571)272-

7606. The examiner can normally be reached on Mondays through Fridays, 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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